

Attorney's Docket: 2000FR303
Serial No.: 09/821,876
Art Unit 1711

REMARKS

Claims 1-16 stand rejected under 35 USC § 103(a) as being obvious from Jacquinot JP 11-246789, FR 2 772 777 or EP 0 926 170 A1 in view of Swofford '828. Applicants traverse this rejection. Applicants have amended claim 1. The multifunctional (meth)acrylic monomer an alkoxylated (meth)acrylate taught in the present application differs from the class taught in the Swofford reference. Applicants have attached a declaration from one of the inventors, which clearly show that the preferred alkoxylated (meth)acrylate taught by Swofford will not work in the instant invention. By contrast the alkoxylated (meth)acrylate of the instant invention have the inherent property of being water insoluble. MPEP 2163.07(a) Inherent Function, Theory, or Advantage holds:

By disclosing in a patent application a device that inherently performs a function or has a property, operates according to a theory or has an advantage, a patent application necessarily discloses that function, theory or advantage, even though it says nothing explicit concerning it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter. In re Reynolds, 443 F.2d 384, 170 USPQ 94 (CCPA 1971); In re Smythe, 480 F. 2d 1376, 178 USPQ 279 (CCPA 1973).

Clearly the Swofford reference did not teach a fluid silico-acrylic compositions, stable in the long term, and nothing in either the Jacquinot or Swofford reference suggest that use of an alkoxylated (meth)acrylate, which are water insoluble, would surprisingly, yield a fluid silico-acrylic compositions, stable in the long term. Based on the amendment to claim 1, and the attached declaration, Applicants respectfully request that the objection to the claims be withdrawn and the claims be allowed.

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As the total number of claims does not exceed the number of claims originally paid for, no fee is believed due. However if an additional fee is required, the Commissioner is hereby authorized to credit any overpayment or charge any fee deficiency to Deposit Account No. 03-2060.

Reconsideration and allowance of this application is respectfully requested.

Respectfully submitted,



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Attachments: Declaration (8 pages)
Extension of time, 1 month, (1 page)